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**REMARKS**

This Amendment is submitted in response to the Office Action mailed June 1, 2006 wherein the Claims 1-5, 10, 13-17, 22, 25-29, and 34 were rejected as being anticipated by US Patent No. 6,564,264 to Creswell et al. ("Creswell"), Claims 6-7, 12, 18-19, 24, 30-31, and 36 were rejected as being unpatentable over Creswell in view of US Pre Grant Publication No. 2002/0143879 to Sommerer ("Sommerer"), Claims 8, 20, and 32 were rejected as being unpatentable over Creswell and further in view of US Pre Grant Publication No. 2003/0131005 to Berry ("Berry"), and Claims 11, 23, and 35 were rejected as being unpatentable over Creswell and further in view of US Pre Grant Publication No. 2004/0267625 to Feng et al ("Feng"), and wherein Claims 9, 21, and 33 were indicated as being allowable if rewritten to include the limitations of their respective base claims and any intervening claims. In response, Applicant has amended Claims 1, 3, 12, 13, 15, 24, 25, 27, and 36, has canceled Claims 2, 11, 14, 23, 26, and 35, and has presented new Claims 37-67 are presented herein. Applicants respectfully submit that no new matter has been entered by any of these amendments. Claims 1, 3-10, 12-13, 15-22, 24-25, and 27-34. and 36-67 are thus pending in the application.

For the reasons set forth below, Applicants respectfully submit that, as amended, all remaining claims in this application are patentably distinct over the prior art of record. Reconsideration and allowance of all pending claims in the application are respectfully solicited.

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**DISQUALIFICATION OF FENG AS PRIOR ART UNDER 35 U.S.C. §103(C)**

The present application, Application No. 10/715,964, and the application to Feng, Application No. 10/606,021, were, at the time the invention of the Application No. 10/715,964 was made, owned by America Online, Inc. Accordingly, Patent  
5 Application No. 10/606,021 is therefore disqualified from being used in a 35 U.S.C. §103(a) rejection. See MPEP 706.02(I)(2).

**NEW CLAIMS**

New Claims 37-67 are directed to a process, an apparatus, and a program  
10 storage medium readable by a computer for updating electronic information in a computer environment. No new matter is introduced by the new claims, support for which is provided below.

New Claims 37, 47, and 57 contain the limitations of original Claims 9, 21, and 33, respectively, including their corresponding base claims and any intervening  
15 claims.

New Claims 38-46 depend on New Claim 37 and contain the recitation of original Claims 2-7 and 10-12.

New Claims 48-56 depend on New Claim 47 and contain the recitation of original Claims 14-19 and 22-24.

20 New Claims 58-66 depend on New Claim 57 and contain the recitation of original Claims 27-34 and 36.

**REJECTION TO THE CLAIMS****Rejection under 35 U.S.C. §102**

25 Claims 1-5, 10, 13-17, 22, 25-29, and 34 were rejected under 35 U.S.C. §102(b) as being anticipated by Creswell. In response, Claims 1, 3, 13, 15, 25, and 27 have been amended to more clearly distinguish the claimed invention over the prior art, Claims 2, 14, and 26 have been canceled. In concert with these amendments, Claims 12, 24, and 36 have been amended to depend on non-  
30 canceled claims and Claims 11, 23, and 35 have been canceled. Applicant

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respectfully submits that the rejection of Claims 2, 14, and 26 is moot, that Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, and 34 as amended, are not anticipated by Creswell, and requests that the rejection of Claims 1-5, 10, 13-17, 22, 25-29, and 34 under §102(b) be withdrawn.

5 Creswell teaches a system and method for updating a user's address book by scanning inbound and outbound e-mail. For outbound e-mail, a message server detects outgoing address errors and updates the user's address book. For incoming mail, inbound headers are scanned for an incorrect address or an address not in the user's address book. The user is notified and the system may correct the user's  
10 address book. The methods for correcting e-mails include looking for typographical errors and looking in databases for alternative not present in the e-mail. Creswell does not explicitly teach a record that is a portion of an address book of a second user in the database, as was noted by the Examiner in section 7 of the Office Action (the rejection of Claims 11, 23, and 35 under 35 U.S.C. §103(a) as being  
15 unpatentable over Creswell and further in view of Feng.).

Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, and 34 as amended, each include a record that is a portion of an address book of a second user. Specifically:

- Claim 1, as amended, includes the recitation of original Claims 2 and 11, which have been canceled, and Claim 3 has been amended to  
20 depend on Claim 1. Claims 1, 3-5, and 10, as amended, thus include the step of updating a record for the second address in a database, wherein the record is a portion of an address book of a second user in the database. In addition, original Claim 12, which depended on canceled Claim 2, has been amended to depend on Claim 1.
- Claim 13, as amended, includes the recitation of original Claims 14  
25 and 23, which have been canceled, and Claim 15 has been amended to depend on Claim 13. Claims 13, 15-17, and 22, as amended, include a module for updating a record for the address in a database, in response to a determination that the message contains information  
30 about the status of the second address, wherein the record is a portion

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of an address book of a second user in the database. In addition, original Claim 24, which depended on canceled Claim 14, has been amended to depend on Claim 13.

- Claim 25, as amended, includes the recitation of original Claims 26 and 35, which have been canceled, and Claim 27 has been amended to depend on Claim 25. Claims 25, 27-29, and 34 as amended, include the step of updating a record for the address in a database wherein the record is a portion of an address book of a second user in the database. In addition, original Claim 36, which depended on canceled Claim 25, has been amended to depend on Claim 25.

Applicant respectfully submits that Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, and 34 as amended, do not teach or suggest updating a record that is a portion of an address book of a second user in the database (Claims 1, 3-5, or 10), a module for updating such a record (Claims 13, 15-17, or 22), or a program storage medium for instructing a computer to update such a record (Claims 25, 27-29, or 34), and as such these claims are not anticipated by Creswell. Applicant therefore respectfully requests that the rejection of Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, and 34 as amended, under §102(b) be withdrawn.

In addition, there is no teaching, suggestion or motivation within Sommerer, Berry, or any other qualified reference, either individually or in combination, to modify the teachings of Creswell to obtain the recitation of any one of Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, or 34, as amended. In addition, Feng cannot be used as a 103(a) reference for the reasons presented above. Thus, for these reasons, the qualified cited references cannot be used to establish a *prima facie* case of obviousness for any of Claims 1, 3-5, 10, 13, 15-17, 22, 25, 27-29, or 34.

#### Rejections under 35 U.S.C. §103

Claims 6-7, 12, 18-19, 24, 30-31, and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Creswell in view of Sommerer. As discussed above, Claims 1, 3, 12, 13, 15, 24, 25, 27, and 36 have been amended to more

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clearly distinguish the claimed invention over the prior art. Applicant respectfully submits that Claims 6-7, 12, 18-19, 24, 30-31, and 36, as amended, are patentable, and requests that the rejection of Claims 6-7, 12, 18-19, 24, 30-31, and 36 as being unpatentable over Creswell in view of Sommerer be withdrawn.

5 Creswell is described above. Sommerer teaches a method for flagging possibly incorrect E-mail addresses within a user's address book. There is no teaching or suggestion in Sommerer of flagging or updating the address book of a second user.

10 Claims 6-7, 12, 18-19, 24, 30-31, and 36, as amended, recite updating a record that is a portion of an address book of a second user in the database (Claims 6-7, and 12), a module for updating such a record (Claims 18-19, and 24), or a program storage medium for instructing a computer to update such a record (Claims 30-31 and 36).

15 There is no teaching, suggestion or motivation in Summerer or any of the other qualified references, either individually or in combination, to modify the teachings of any of the qualified references to obtain the invention as claimed in any of Claims 6-7, 12, 18-19, 24, 30-31, or 36, as amended. Thus, for these reasons, the references cannot be used to establish a *prima facie* case of obviousness for any of Claims 6-7, 12, 18-19, 24, 30-31, and 36, as amended, and Application respectfully  
20 requests that the rejections of Claims 6-7, 12, 18-19, 24, 30-31, and 36 under 35 U.S.C. §103(a) be withdrawn.

Claims 8, 20, and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Creswell in view of Berry. As discussed above, the claims have been amended to more clearly distinguish the claimed invention over the prior art.  
25 Applicant respectfully submits that Claims 8, 20, and 32 as amended, are patentable, and requests that the rejection of Claims 8, 20, and 32 as being unpatentable over Creswell in view of Berry be withdrawn.

Creswell is described above. Berry teaches a method for pruning search engine indices. There is no teaching or suggestion in Berry of flagging or updating  
30 the address book of a second user.

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Claims 8, 20, and 32, as amended, recite updating a record that is a portion of an address book of a second user in the database (Claim 8), a module for updating such a record (Claim 20), or a program storage medium for instructing a computer to update such a record (Claim 32).

5        There is no teaching, suggestion or motivation in Berry or any of the other qualified references, either individually or in combination, to modify the teachings of Creswell to obtain the invention as claimed in any of Claims 8, 20, or 32, as amended. Thus, for these reasons, the references cannot be used to establish a *prima facie* case of obviousness for any of Claims 8, 20, and 32, as amended, and  
10        Application respectfully requests that the rejections of Claims 8, 20, and 32 under 35 U.S.C. §103(a) be withdrawn.

      Claims 11, 23, and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Creswell in view of Feng. As discussed above, Claims 11, 23, and 35 have been canceled, and the recitations of the original Claims 11, 23, and 35 are  
15        now found in Claims 1, 13, and 35, as amended. As noted above, Feng, due to common ownership at the time of invention, is disqualified as a 103(a) reference, and thus Claims 1, 13, and 35, as amended, as well as the other pending claims, are believed to be allowable.

20        **ALLOWABLE SUBJECT MATTER**

      The Examiner has indicated that the subject matter of Claims 9, 21, and 33 were objected to and that would be allowable if rewritten in independent form to include all of the limitations of the base and any intervening claims. Applicant acknowledges the Allowable subject matter, which is presented in the New claims as  
25        follows.

      The limitations of original Claims 9, 21, and 33, including their corresponding base claims and any intervening claims, are presented in new Claims 37, 47, and 57, respectively, and thus Claims 37, 47, and 57 are believed to be in condition for allowance.

30        New Claims 38-46 depend on Claim 37 and contain the recitation of original

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Claims 2-7 and 10-12; New Claims 48-56 depend on Claim 47 and contain the recitation of original Claims 14-19 and 22-24; and Claims 58-66 depend on Claim 57 and contain the recitation of original Claims 27-34 and 36. Since each of Claims 38-46, 48-56, and 58-66 depend on allowable Claims, Applicant submits that these

5 claims are also allowable.

Applicant respectfully submits that the application is in condition for allowance and action to that end is respectfully solicited. If the Examiner should feel that a telephone interview would be productive in resolving any issues in the case, please telephone the undersigned at the number listed below.

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Respectfully submitted,



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